UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,188	07/13/2001	Jack Egan	361331-510	3061

30623 7590 10/06/2004

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY
AND POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

EXAMINER	
DELACROIX MUIRHEI, CYBILLE	

ART UNIT	PAPER NUMBER
1614	

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/905,188	EGAN ET AL.	
	Examiner	Art Unit	
	Cybille Delacroix-Muirheid	1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,7-10 and 12-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,7-10 and 12-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

The following is responsive to Applicant's amendment received June 23, 2004.

Claims 5, 6, 11 are cancelled. New claims 12-14 are added.

Claims 1-4, 7-10, 12-14 are currently pending.

Information Disclosure Statement(s)

Applicant's information disclosure statement received June 23, 2004 has been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

Response to Amendment/Remarks

The previous claim objection set forth in paragraph 1 of the office action mailed March. 23, 2004 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

The previous claim rejection under 35 USC 103(a), set forth in paragraph 2 of the office action mailed March 23, 2004 **is withdrawn** in view of Applicant's amendment and the remarks contained therein.

However, Applicant's amendment necessitates the following new ground(s) of rejection.

New Ground(s) of Rejection

Claim Rejection(s)—35 USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-4, 7-10, 12-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claim 1, the limitation, "(A) an effective amount of an antioxidant, angiotensin converting enzyme (ACE) inhibitor, angiotensin II receptor antagonist, calcium channel blocker, diuretic, digitalis, beta blocker, statin or cholestyramine; and", at lines 4-6, introduces new matter into the claims. Upon reference to pages 21 and 22 of the specification, it does not appear that Applicant has support for the claims as amended. The specification only provides support for the claimed combination therapy only when it is used to treat cardiovascular therapies (antioxidants), or heart failure, cardiomyopathy or heart attack or atherosclerosis. The specification does not support a method of treating, ameliorating or preventing hypertension or systolic hypertension in an animal by administering to the animal the claimed combination. One of ordinary skill in the art would not come to the conclusion that, at the time the application was filed, Applicant had possession the method as claimed.

Claim Rejection(s)—35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-4, 7-10, 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cerami et al., 5,853,703 in view of Goodman & Gilman's, The Pharmacological Basis of Therapeutics.

Cerami et al. disclose a method of inhibiting and reversing protein aging by administering to a patient in need thereof an effective amount of a thiazolium compound represented by Formula (I). Specifically, Cerami et al. teach that the method has therapeutic applications and that the thiazolium compound can be used in a method for treating hypertension. A preferred compound used in the therapeutic method is 3-(2-

phenyl-2-oxoethyl)-4,5-dimethyl-thiazolium bromide. Finally, Cerami et al. teach that pharmaceutically acceptable salts of the compounds may also be used in the disclosed method. Please see the abstract; col. 2, line 47 to col. 3, line 29; col. 7, lines 12-18 and 25-35.

Cerami et al. do not disclose combining the preferred compound with an ACE inhibitor, calcium channel blocker, diuretic, etc. However, the Examiner refers to Goodman & Gilman's, which teaches various agents for treating hypertension, wherein the agents comprise diuretics, calcium channel blockers, ACE inhibitors, angiotensin II receptor antagonists. Please see pages 780-803.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the thiazolium compound in Cerami with the known anti-hypertensive agents taught by Goodman & Gilman's because one of ordinary skill in the art would reasonably expect the additive effect of the compounds to be effective in treating hypertension. Furthermore, one of ordinary skill in the art would reasonably expect the anti-hypertensive agents of Goodman & Gilman's to be effective in the hypertension treatment method disclosed by Cerami et al. Finally, Cerami and Goodman & Gilman's teach that 3-(2-phenyl-2-oxoethyl)-4,5-dimethyl-thiazolium bromide and diuretics, calcium channel blockers, ACE inhibitors etc. are known in the art to be useful for treating hypertension. Modification to combine these agents all of which are known to be useful for the same purpose, would have been obvious to one of ordinary skill in the art in view of the fact that the courts have held "it is prima facie obvious to combine two compositions each of which is taught by the prior art to be

useful for the same purpose, in order to form a third composition which is to be used for the very same purpose". Please see In re Susi, 169 USPQ 423, 426 (CCPA 1971); In re Kerkhoven, 205 USPQ 1069 (CCPA 1980).

Additionally, Cerami et al. do not specifically disclose administering the elected compound 3-(2-phenyl-2-oxoethyl)-4,5-dimethyl-thiazolium chloride; however, the Examiner refers to col. 7, lines 10-11, where Cerami et al. teach that the halo atom used in the thiazolium compounds may also be chloride. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to administer 3-(2-phenyl-2-oxoethyl)-4,5-dimethyl-thiazolium chloride because, in view of Cerami et al.'s teaching, one of ordinary skill in the art would reasonably expect the chloride compound to be effective in treating hypertension. Such a modification would have been motivated by the reasonable expectation that the chloride compound would have similar properties, and thus the same use as the bromide compound.

Conclusion

Claims 1-4, 7-10, 12-14 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Cybille Delacroix-Muirheid** whose telephone number is **571-272-0572**. The examiner can normally be reached on Mon-Thurs. from 8:30 to 6:00 as well as every other Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher Low**, can be reached on **571-272-0951**. The fax phone number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CDM
Oct. 4, 2004

Phyllis Spivack

PHYLLIS SPIVACK
PRIMARY EXAMINER